

U.S.S.N. 09/821,203

Filed: March 29, 2001

**AMENDMENT AND RESPONSE TO OFFICE ACTION**

**Remarks**

Claims 21-29 are pending. Claims 21, 22, 26, 28 have been amended. Claim 28 was amended to correct a minor typographical error. Claim 21 was amended to clarify how the changes in expression of genes in the microarray are detected (comparing levels of gene expression and detecting changes between the genes arrayed and control genes). Claim 22 was amended to clarify the second library of genes as being from cells having a different state, disease or disorder. Support for the amendments to claims 21 and 22 can be found, for example, at page 7, lines 12-18. Claim 26 was amended to incorporate some of the language of claim 21. The DNA library of claim 26 now contains genes that comprise an E-box regulatory sequence, or encode proteins or cofactors that bind to the E-box regulatory sequence.

**Rejection Under 35 U.S.C. § 112, second paragraph**

Claims 21-29 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse this rejection to the extent that it is applied to the claims as amended.

Claim 21 was amended to clarify that levels of gene expression are compared (via hybridization between the amplicon and the labeled probe) and any changes between hybridized spots on the array and control genes are detected.

Claim 22 was amended to clarify the second library of genes.

Claim 26 was amended to more clearly define the genes that may encode proteins or cofactors that bind to the E-box regulatory sequence. Furthermore, claim 26 is directed to determining the effect of a compound on a disease or state of an individual by, *inter alia*,

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obtaining genes, for the library, "from the individual after treatment of the individual, or cells or tissues derived therefrom" and providing the library to the compound or a particular dosage regime of the compound (see part "a" of claim 26). The changes in expression are subsequently correlated with the state, disease or disorder that was present prior to the treatment (see part "c" of claim 26).

Allowance of claims 21-29 is respectfully solicited.

Respectfully submitted,



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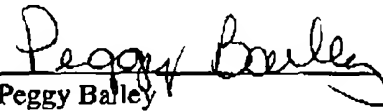
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**Certificate of Facsimile Transmission**

I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being facsimile transmitted on this date, **November 13, 2003**, to the Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Peggy Bailey

Date: November 14, 2003

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